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U.S. Application No. 09/923,320 Examiner MARTIN Art Unit 2154
Submission of Amendment with RCE in Response to June 28, 2005 Final Office Action

REMARKS

In response to the final Office Action dated June 28, 2005, the Assignee respectfully requests continued examination and reconsideration based on the above claim amendments and the following remarks. The Assignee respectfully submits that the amended claims distinguish over the cited documents of record.

The United States Patent and Trademark Office (the "Office") rejected claims 1, 7-13, 16-20, 24-30, 34-44, 46-48, and 55-56 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,301,609 to Aravamudan *et al.* Claims 3, 21, and 31 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Aravamudan* in view of Published United States Patent Application 2001/0051989 to Moncreiff. Claims 4, 22, and 32 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Aravamudan* in view of Published United States Patent Application 2002/0028708 to Busch *et al.* Claims 5-6, 23, 33, and 51-54 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Aravamudan* in view of Published United States Patent Application 2004/0073507 to Scott *et al.* Claims 14-15 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Aravamudan* in view of Published United States Patent Application 2002/0124100 to Adams. The Assignee shows, however, that the pending claims are patentably distinguishable over *Aravamudan*, *Moncreiff*, *Busch*, *Scott*, and/or *Adams*, whether considered singularly or in any combination.

Rejection of Claims under 35 U.S.C. § 102 (e)

The United States Patent and Trademark Office (the "Office") rejected claims 1, 7-13, 16-20, 24-30, 34-44, 46-48, and 55-56 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,301,609 to Aravamudan *et al.* A claim is anticipated only if each and every element is found in a single prior art reference. See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). See also DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8th Edition) (hereinafter "M.P.E.P."). As the Assignee shows, the amended claims are patentably distinguishable over *Aravamudan*. The reference to *Aravamudan* does not anticipate the claims, so the Assignee

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respectfully requests that Examiner Martin remove the 35 U.S.C. § 102 (e) rejection of the claims.

The pending claims have been amended. All the claims now recite methods, computers, or other systems that notify an offline user of an online user. The number of users who log into the website is monitored. As each as each user logs in, notification criteria of the offline user is compared to the number of logged in users. The notification criteria specify a particular number of users that log in to the website. When the particular number of users exceeds a preset amount, then a notification is sent to the offline user. The notification informs the offline user of an amount of activity in the website. Support for such features may be found at least at paragraphs [0022], [0024], [0026], [0051], [0065], [0067], and [0092]. A "clean" version of claim 1, for example, is reproduced below.

1. (Currently Amended) A method for notifying an offline user of an online user, the method comprising the steps of:

monitoring the number of users who log in to a website;
as each user logs in, comparing notification criteria of the offline user, the notification criteria specifying a particular number of users that log in to the website; and
when the particular number of users exceeds a preset amount, then sending a notification to the offline user, the notification informing the offline user of an amount of activity in the website.

All the other independent claims include similar features.

Aravamudan does not anticipate the claims. *Aravamudan* is completely silent to monitoring the number of users that log in to a website and sending a notification when the number of users exceeds a preset amount. The notification informs the offline user of an amount of activity in the website. Because *Aravamudan* fails to contemplate such features, the Assignee respectfully requests that Examiner Martin remove the 35 U.S.C. § 102 (e) rejection of the claims.

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Rejection of Claims 3, 21, and 31 under 35 U.S.C. § 103 (a)

Claims 3, 21, and 31 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Aravamudan* in view of Published United States Patent Application 2001/0051989 to Moncreiff. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) the Examiner must identify "some suggestion or motivation...to modify the reference"; 2) the Examiner must identify "a reasonable expectation of success"; and 3) "the prior art reference must teach or suggest all the claim limitations." DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P."). The Assignee shows, however, that the attempted combination of *Aravamudan* and *Moncreiff* fails to teach or suggest all the features recited in the independent claims. The Assignee also shows that Examiner Martin has failed to properly present a *prima facie* case for obviousness. The Assignee thus respectfully requests that Examiner Martin remove the § 103 (a) rejection.

The independent claims are not obvious. All the independent claims recite methods, computers, or other systems that notify an offline user of an online user. . The number of users who log into the website is monitored. As each as each user logs in, notification criteria of the offline user is compared to the number of logged in users. The notification criteria specify a particular number of users that log in to the website. When the particular number of users exceeds a preset amount, then a notification is sent to the offline user. The notification informs the offline user of an amount of activity in the website.

The Examiner's proposed combination of *Aravamudan* and *Moncreiff* fails to teach or suggest such features. The proposed combination of *Aravamudan* and *Moncreiff* is silent to the features recited in the independent claims. No where does *Aravamudan* and/or *Moncreiff* teach or suggest "when the particular number of users exceeds a preset amount, then sending a notification to the offline user, the notification informing the offline user of an amount of activity in the website."

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Examiner Martin is correct — several times *Moncreiff* discusses the number of users in a chat room. See, e.g., Published United States Patent Application 2001/0051989 to Moncreiff (Dec. 13, 2001) at paragraphs [0009], [0045], [0050], [0057], [0058], and [0059]. No where, however, does *Moncreiff* teach or suggest “when the particular number of users exceeds a preset amount, then sending a notification to the offline user, the notification informing the offline user of an amount of activity in the website” (emphasis added). Examiner Martin points to paragraph [0003], but the Assignee finds no such teaching or suggestion. Paragraph [0003] reviews the basics of chat room use, such as “relaying” text between “occupants” of the chat room. Paragraph [0003] also describes how two users can arrange to “meet” in a private chat room for private conversation. Neither paragraph [0003], nor *Moncreiff in toto*, teach or suggest the features recited in the independent claims. The Assignee thus respectfully requests that Examiner Martin remove the § 103 (a) rejection.

Rejection of Claims 4, 22 & 32 under 35 U.S.C. § 103 (a)

Claims 4, 22, and 32 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Aravamudan* in view of Published United States Patent Application 2002/0028708 to Busch *et al.* The Examiner’s proposed combination of *Aravamudan* and *Busch*, however, again fails to teach or suggest the features recited in the independent claims. No where does *Aravamudan* and/or *Busch* teach or suggest “monitoring the number of users who log in to a website.” “As each user logs in, comparing notification criteria of the offline user, the notification criteria specifying a particular number of users that log in to the website.” “When the particular number of users exceeds a preset amount, then sending a notification to the offline user, the notification informing the offline user of an amount of activity in the website.” No where do *Aravamudan* and/or *Busch* teach or suggest such features. One of ordinary skill in the art, then, would not find the claims obvious. The Assignee thus respectfully requests that Examiner Martin remove the § 103 (a) rejection.

The Examiner’s *prima facie* case must fail for other reasons. Claims 4, 22, and 32 also recite other features not taught or suggested by *Aravamudan* and/or *Busch*. Claims 4, 22, and 32,

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for example, recite "wherein the website is a game site and *the notification criteria further comprise when a high score has been exceeded.*" Neither *Aravamudan* nor *Busch* disclose such features, so one of ordinary skill in the art would not find the claims obvious. The Assignee thus respectfully requests that Examiner Martin remove the § 103 (a) rejection.

Rejection of Claims 5-6, 22-23 & 51-54 under 35 U.S.C. § 103 (a)

Claims 5-6, 23, 33, and 51-54 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Aravamudan* in view of Published United States Patent Application 2004/0073507 to Scott *et al.* These claims, however, all recite, or incorporate, the distinguishing features of the independent claims. These claims, for example, all incorporate "*monitoring the number of users who log in to a website.*" "*As each user logs in, comparing notification criteria of the offline user, the notification criteria specifying a particular number of users that log in to the website.*" "*When the particular number of users exceeds a preset amount, then sending a notification to the offline user, the notification informing the offline user of an amount of activity in the website.*" No where do *Aravamudan* and/or *Scott* teach or suggest such features. One of ordinary skill in the art, then, would not find the claims obvious. The Assignee thus respectfully requests that Examiner Martin remove the § 103 (a) rejection.

The Examiner's *prima facie* case must fail for other reasons. Claims 5-6, 23, 33, and 52 also recite other features not taught or suggested by *Aravamudan* and/or *Busch*. These claims, for example, recite "wherein the website is an auction site and *the notification criteria comprise entry of a bid that exceeds a high bid submitted by the offline user*" (emphasis added). No where do *Aravamudan* and/or *Scott* teach or suggest such features. One of ordinary skill in the art, then, would not find the claims obvious. The Assignee thus respectfully requests that Examiner Martin remove the § 103 (a) rejection.

Rejection of Claims 14-15 under 35 U.S.C. § 103 (a)

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Claims 14-15 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Aravamudan* in view of Published United States Patent Application 2002/0124100 to Adams. The Examiner's proposed combination of *Aravamudan* and *Scott*, however, again fails to teach or suggest the features recited in the independent claims. No where does *Leseber* and/or *Scott* teach or suggest: "monitoring the number of users who log in to a website." "As each user logs in, comparing notification criteria of the offline user, the notification criteria specifying a particular number of users that log in to the website." "When the particular number of users exceeds a preset amount, then sending a notification to the offline user, the notification informing the offline user of an amount of activity in the website." Neither *Aravamudan* nor *Scott* teach or suggest these features, so the Assignee thus respectfully requests that Examiner Martin remove the § 103 (a) rejection.

If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 387-6907 or scott@scottzimmerman.com.

Respectfully submitted,



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